APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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BANNER & WITCOFF LTD.,
ATTORNEYS FOR CLIENT NOS. 003797 & 013797
1001 G STREET , N.W.
SUITE 1100
WASHINGTON, DC 20001-4597

EXAMINER
LEWIS, ALICIA M

ART UNIT	PAPER NUMBER
2164	

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/766,319	MADAN ET AL.
	Examiner	Art Unit	
	Alicia M. Lewis	2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>26 January 2004</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-12</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-12</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>02 July 2004</u> is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1.   The information disclosure statement (IDS) submitted on April 26, 2004 is in

compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure

statement is being considered by the examiner.

Drawings

2.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5)

because they do not include the following reference sign(s) mentioned in the

description: 402, 510, 606 and 1208. Corrected drawing sheets in compliance with 37

CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the

application. Any amended replacement drawing sheet should include all of the figures

appearing on the immediate prior version of the sheet, even if only one figure is being

amended. Each drawing sheet submitted after the filing date of an application must be

labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37

CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be

notified and informed of any required corrective action in the next Office action. The

objection to the drawings will not be held in abeyance.

3.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5)

because they include the following reference character(s) not mentioned in the

description: element 1009 in Figure 10 and elements 1304 and 1308 in Figure 13.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the

specification to add the reference character(s) in the description in compliance with 37

CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the

application. Any amended replacement drawing sheet should include all of the figures

appearing on the immediate prior version of the sheet, even if only one figure is being

amended. Each drawing sheet submitted after the filing date of an application must be

labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37

CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be

notified and informed of any required corrective action in the next Office action. The

objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 1-3, 8 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by

Carro (US Patent Application Publication 2003/0117378 A1).

With respect to claim 1, Carro teaches a computer system for associating selected content and context information comprising:

an input for receiving selected content (paragraphs 5 and 51);

a processor (paragraph 64) that obtains context information relating to said selected content (paragraphs 4, 43 and 51); and

an output that outputs an association between said selected content and said context (paragraphs 52 and 53).

With respect to claim 2, Carro teaches the system according to claim 1, further comprising:

a storage for storing that association between said selected content and said context (paragraph 54).

With respect to claim 3, Carro teaches the system according to claim 1, further comprising:

a storage for storing that association between said selected content and said context (paragraph 54), wherein said association is a single file (paragraph 55).

With respect to claim 8, Carro teaches the system according to claim 1, wherein said context information includes text related to a selected region (Figure 6, paragraph 51).

With respect to claim 9, Carro teaches the system according to claim 1, wherein said context information includes electronic ink (paragraph 6).

6.   Claims 10 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Carroll (US Patent 6,762,777 B2).

With respect to claim 10, Carroll teaches a method for obtaining context information comprising the steps of:

receiving a selected region (column 2 line 31);

determining a window associated with said selected region (column 2 lines 31-33);

retrieving an interface from said window (column 4, lines 50-57);

storing a property of said window as context information (column 2 lines 46-62, column 3 lines 39-41).

With respect to claim 11, Carroll teaches the method according to claim 10, further comprising the step of: if no property is found, then moving to a parent window of said window.

A popup window is associated with a selected region, therefore a property will always be found. Also, the specification and drawings show that a parent window is not mandatory, thus Carroll meets the limitations of this claim.

7.   Claim 12 is rejected under 35 U.S.C. 102(e) as being anticipated by Dawe et al.

(US Patent 7,042,594) ('Dawe').

        With respect to claim 12, Dawe teaches a method for determining text associated

with a selected region comprising the steps of:

        determining an element within said selected region (step 202 in Figure 3, column

5 lines 1-3, column 6 lines 42-51);

        determining the type of text of said element (steps 204 and 206 in Figure 3,

column 4 lines 12-14, column 5 lines 36-41, column 7 lines 6-20);

        determining the bounding box of the text within said element (column 5 lines 3-9,

column 7 lines 49-56);

        comparing the bounding box of said text with the shape of said selected region

(column 5 lines 9-10, column 7 lines 53-56);

        storing as context information actual text relating to text within said selected

region (step 209 in Figure 3, column 5 lines 11-16, column 7 lines 57-60).

                          Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

9.   Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carro (US

Patent Application Publication 2003/0117378 A1) in view of Ross et al. (US Patent

5,983,215) ('Ross').

        With respect to claim 4, Carro teaches the system according to claim 1, further

comprising: a storage for storing the association between said selected content and

said context (paragraph 54).

        Carro does not teach wherein said association is at least two files connected by

at least one pointer.

        Ross teaches a system and method for performing joins and self-joins in a

database system (see abstract), in which he teaches wherein said association is at least

two files connected by at least one pointer (column 25, claim 24).

        It would have been obvious to a person having ordinary skill in the art at the time

the invention was made to have modified Carro by the teaching of Ross because

wherein said association is at least two files connected by at least one pointer would

enable the maximization of the usage of available main memory (column 3 lines 65-66).

10.   Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Carro (US Patent Application Publication 2003/0117378 A1) in view of Chen et al. (US

Patent Application Publication 2005/0154993 A1) ('Chen').

        With respect to claim 5, Carro teaches the system according to claim 1.

        Carro does not teach wherein said context information includes a URL.

Chen teaches an automatic reference generator (see abstract) in which he teaches wherein said context information includes a URL (abstract).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Carro by the teaching of Chen because wherein said context information includes a URL would enable more functionality to Carro's invention such as the ability to automatically generate footnotes, end notes, and bibliographical entries (abstract).

With respect to claims 6 and 7, Carro as modified teaches the system according to claim 1, wherein said context information includes a file/folder name (abstract).

It is inherent that if a file name may be included, then a folder name may be included because both are text elements.

11.   Claim 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carro (US Patent Application Publication 2003/0117378 A1) in view of Denoue et al. (US Patent Application Publication 2004/0119762 A1) ('Denoue').

With respect to claim 5, Carro teaches the system according to claim 1.

Carro does not teach wherein said context information includes a URL.

Denoue teaches systems and methods for freeform pasting (see abstract) in which he teaches wherein said context information includes a URL (paragraphs 75 and 78).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Carro by the teaching of Denoue because wherein said context information includes a URL would enable more functionality to Carro's invention such as the ability to manipulate information, like digital content, on large screen displays or in composite documents, and methods for collaborative note taking.

With respect to claims 6 and 7, Carro as modified teaches the system according to claim 1, wherein said context information includes a file/folder name (paragraphs 75 and 76 and 79).

It is inherent that if a file name may be included, then a folder name may be included because both are text elements.

SAM RIMELL
PRIMARY EXAMINER